

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION**

HY-KO PRODUCTS COMPANY LLC,

Plaintiff,

v.

THE HILLMAN GROUP, INC.

Defendant.

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Case No. 2:21-CV-00197-JRG

JURY TRIAL DEMANDED

**JOINT MOTION REGARDING STIPULATION OF DISMISSAL OF '432 PATENT
AND INEQUITABLE CONDUCT COUNTERCLAIM AND DEFENSE**

Plaintiff and counterclaimant Hy-Ko Products Company LLC (“Hy-Ko”) and defendant and counterclaimant The Hillman Group, Inc. (“Hy-Ko”) respectfully submit this joint motion requesting that the Court adopt and enter the following stipulation regarding U.S. Patent 9,682,432 (“the ’432 Patent”).

WHEREAS, Hy-Ko has asserted that Hillman infringes the ’432 Patent as Count II of Hy-Ko’s Amended Complaint (Dkt. 14);

WHEREAS, Hillman has asserted (a) counterclaims for declaratory judgment that Hillman does not infringe the ’432 Patent and other patents-in-suit, (b) that the ’432 Patent and other patents-in-suit are invalid and/or unenforceable), and (c) that Hy-Ko breached a 2012 settlement agreement with Hillman for filing suit on the ’432 Patent and the other patents-in-suit (Dkt. 89).

WHEREAS, Hillman has asserted in its Third Counterclaim that the patents-in-suit are unenforceable for, *inter alia*, inequitable conduct before the United States Patent and Trademark Office (“USPTO”).

NOW, THEREFORE, in consideration thereof and of the mutual agreements, and for other good and valuable consideration, the parties hereby stipulate and agree as follows:

1. Count II of Hy-Ko's Amended Complaint (Dkt 14), alleging infringement of the '432 Patent, is dismissed with prejudice.

2. The portion of Hillman's First, Second and Third Counterclaims solely related to infringement, validity or unenforceability of the '432 Patent is dismissed without prejudice.

3. The portion of Hillman's Third Counterclaim solely related to inequitable conduct regarding the patents-in-suit is dismissed without prejudice.

4. Hillman withdraws its defenses related solely to the '432 Patent, its inequitable conduct defense and dismisses without prejudice those aspects of its breach of contract counterclaim that relate solely to the '432 Patent. For clarity, Hillman will continue to assert its breach of contract counterclaim based on Hy-Ko's initiation of this lawsuit and Hy-Ko's assertions on the remaining patents-in-suit. Also for clarity, Hillman reserves the right to file a claim for breach of the 2012 Settlement regarding the '432 Patent only in the event Hy-Ko attempts to file a new lawsuit on the '432 patent (or any other patent-in-suit) as well as any rights to claim the '432 Patent is invalid, non-infringed, unenforceable.

Dated: September 19, 2022

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Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the above and foregoing was electronically filed with the CM/ECF system per LR 5.1, and that all interested parties are being served with a true and correct copy of these documents via the CM/ECF system on September 19, 2022.

/s/ Kevin Schubert
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